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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/786,690	02/25/2004	Jorge Armando Ayala	A03148US (98786.5)	3685
22920 7590 06/23/2008 GARVEY SMITH NEHRBASS & NORTH, LLC LAKEWAY 3, SUITE 3290 3838 NORTH CAUSEWAY BLVD. METAIRIE, LA 70002				
EXAMINER HENDRICKSON, STUART L				
ART UNIT		PAPER NUMBER		
1793				
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06/23/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/786,690

Applicant(s)

AYALA ET AL.

Examiner

Stuart Hendrickson

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 February 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) 13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action. The supplemental amendment does not meet the requirements (MPEP 714.03a) but is accepted upon charging of a fee for one additional month extension.

The response of 2/22/08 presents claim 13, drawn to an invention patentably distinct from that which was previously claimed because it is a method of use in class 524/495. The composition of claim 1-12 has a different use, such as in an ink or with a plastic. There is a burden of search. Had this claim been presented originally, it would have been restricted. Therefore, the inventions are distinct. Claim 13 is thus withdrawn from consideration. See MPEP 821.03 for example.

Claims 1-12 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3, 5, 7-9, 15-25 of copending Application No. 10/666048. Although the conflicting claims are not identical, they are not patentably distinct from each other because they claim common subject matter; the analytical properties recited are identical. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1-12 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Yoshimura 4693879.

The reference teaches in col. 1 and col. 8, 9 in particular heat treated carbon blacks, for use with polymers. No difference is seen in the properties of the carbon blacks.

Claims 1-12 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Johnson 3408164.

The reference teaches in col. 1 and col. 8, 9 in particular heat treated carbon blacks, for use with polymers. No difference is seen in the properties of the carbon blacks.

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Claims 1-12 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over EP '024.

The reference teaches, in the abstract, carbon blacks having the claimed properties. No differences are seen for the above reasons. Claims 5 and 6 do not clearly require a polymer.

Claims 1-12 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Atchetee et al.

The reference teaches carbon black with rubber. No difference is seen between bladder compounds and the polymers of the reference. No difference is seen between oil of the claims and DBPA, since DBP is an oil. No difference is seen in the 'heat treated' verbiage, given that the actual analytical parameters are or can be the same. Overlapping numerical ranges render the claims prima-facie unpatentable; see *In re Malagari* 182 USPQ 549.

Claims 1-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A) It is unclear what a 'curing bladder' is in claim 1 and 9.

B) Claims 5 and 12 are unclear as to what components are in the composition. As only one ingredient is recited, it is self-contradictory. It is not clear what, if any, difference there is between these claims.

Applicant's arguments filed 2/22/08 have been fully considered but they are not persuasive.

The TD is being evaluated. Specification pgs 34 and 35 do not explain what a curing bladder is. The fallacy in the argument that the claims are allowable over '024 and Atchetee can be illustrated by taking it to its logical conclusion: If the claims stated an oil area of 0-infinity and a size of 0-infinity, it would be impossible to reject the claims. The composition/use is not

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examined, so arguments thereto are moot- no unexpected results have been shown. The claims are to a product, so process limitations are not relevant. What temperatures are excluded from the claims? There is only one Atchetee reference of record, so there is no confusion as to what the rejection is.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication, EXCEPT about the Terminal disclaimer, should be directed to examiner Hendrickson at telephone number (571) 272-1351.

/Stuart Hendrickson/
examiner Art Unit 1793